



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,668	01/18/2002	Stefan Lundgren	230.014	6841

7590

01/26/2005

David D Stein  
Boyle Fredrickson Newholm Stein & Gratz  
250 Plaza Suite 1030  
250 East Wisconsin Avenue  
Milwaukee, WI 53202

EXAMINER

ASHBURN, STEVEN L

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/031,668

Applicant(s)

LUNDGREN ET AL.

Examiner

Steven Ashburn

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-16,21-26,28-42 and 44-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-16,21-26,28-42 and 44-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Claim Rejections - 35 USC § 102**

**Claims 1-5, 7, 9, 10, 12, 15, 16, 21-26, 28, 30, 31, 33, 36—42, 44, 45 and 47-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Evans, US 3,717,857 (Feb. 20, 1973)**

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

**Claims 1, 7-11, 23, 25, 29, 32, 34, 46, 49 and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Morgan, US 6,461,245 (Oct. 8, 2002).**

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

### **Claim Rejections - 35 USC § 103**

**Claims 14, 35 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan in view of Cleveland, US 5,816,953 (Oct. 6, 1998).**

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

### **Response to Arguments**

Applicant's arguments filed October 8, 2004 have been fully considered but they are not persuasive. The examiner's response to each argument is provided below.

The applicant argues that the claimed invention, as amended, is not anticipated by Evans or Morgan because the references do not disclose a selection device configured to selected a pre-stored

Art Unit: 3714

action program dependent upon a profile or action program. The examiner respectfully disagrees. First, Evans discloses a switching circuit for selecting action parameters stored in memory for display dependent upon the parameters selected for a user's performance. *See col. 5:1-14, 4:33-49*. Thus, Evans anticipates the claim limitation. Second, Morgan discloses a selection means for selecting performance data stored in memory for comparison to a player's profile data depending on the selected data. *See col. 6:45-8:9*. Thus, Morgan also anticipates the claim limitation.

Furthermore, the applicant asserts that the claimed invention is not anticipated by the prior art because it automatically selects a pre-stored action program. In response, it is noted that this features is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *See In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In particular, the claims merely describe a device which selects an action program dependent on a profile. This limitation may be met by a manual switch. Thus the argument is unpersuasive. Notably, it *per se* obvious to automate a manual activity to accomplish the same result. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

Furthermore, the applicant asserts that the claims are not anticipated by Morgan because the reference teaches away from the invention. The examiner respectfully disagrees. A claim is anticipated if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As discussed above, Morgan anticipates each and every element of the claims. Thus, the argument is unpersuasive.

Art Unit: 3714

Furthermore, the applicant argues that claims 14, 35 and 52 are unobvious over Morgan in view of Cleveland because Cleveland does not describe the features of a ratio or percentage distribution of successful shots. The examiner respectfully disagrees. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The standard of patentability is what the prior art, taken as a whole, suggests to an artisan at the time of the invention. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The question is not only what the references expressly teach, but what they would collectively suggest to one of ordinary skill in the art. *In re Simon*, 461 F.2d 1387, 1390, 174 USPQ 114, 116 (CCPA 1972). In this case Morgan disclose a system adapted to track the properties of a golf player wherein a ratio or percentage distribution of successful shots is recorded and displayed. See *fig. 9A-9J*. Cleveland discloses an analogous system for tracking the performance of a tennis player. When the prior art is taken as a whole by an artisan at the time of the invention, it collectively suggests a tennis training system wherein a ratio or percentage distribution of successful shots. As suggested by Cleveland, tracking and recording a tennis player's performance enhances the players improvement in the sport by allowing it to be compared and with prior performances. See *col. 2:29-4:8*.

#### **Prior Art, Not Relied On**

The following prior art of record is not relied upon but is considered pertinent to applicant's disclosure:

US 6,514,081 discloses a automated system for analyzing motion analysis having a selection device configured to selected a pre-stored action program dependent upon a profile or action program. See, e.g., *col. 2:14-58, 6:19-34*.


**Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 571-272-4445. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on 571-272-4119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

s.a.



JESSICA HARRISON  
PRIMARY EXAMINER